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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/766,916

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Jean-Louis Gueret

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EXAMINER

PICKETT, JOHN G

ART UNIT

PAPER NUMBER

3728

MAIL DATE

DELIVERY MODE

05/29/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/766,916

Applicant(s)

GUERET, JEAN-LOUIS

Examiner

Greg Pickett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 13 April 2007 has been entered. Claims 1-39 are pending in the application. Claims 36-39 are new.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

3. Applicant's amendment to claim 1 has overcome the rejection of claims 1, 7-10, 13, 16-18, 24, 26, 32, and 33 under 35 U.S.C. 102(b) as being anticipated by Vicari (US 6,216,899; provided by applicant).

Claim Rejections - 35 USC § 103

4. Claims 1-3, 11, 12, 14, 15, 17-21, 24, 26-31, and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manougian et al (US 7,047,983 B2; hereinafter Manougian) in view of Rago et al (US 6,626,432 B2; hereinafter Rago).

Claim 1: Manougian discloses a box **210** (see Figure 7) comprising a base portion **218**, a lid **216**, and a hinge **220**. Manougian discloses the claimed invention except that Manougian uses a pinned hinge instead of a hook-and-loop hinge.

Rago discloses a hinge **22** (see Figure 6) with a first element **62** comprising loop materials and a second element **72** comprising hook materials. Rago shows that a hook-and-loop hinge was an equivalent structure known in the art. Therefore, because these two hinge means were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute the hook-and-loop of Rago for the pinned hinge of Manougian. An express suggestion to substitute one equivalent component or process for another is not necessary to render such substitution obvious. *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982).

Manougian, as modified with the hinge of Rago, is fully capable of holding the lid in an upstanding position.

Claims 2, 17, 18, and 21: An interpretation of Manougian discloses a base portion **218** with a top face **258** and rear face (sidewall near hinge **220**), and a lid with a bottom face **264** and rear face (sidewall near hinge **220**). Rago teaches the hook-and-loop fastener wrapping around the top, side, and bottom of the base and lid (see Figure 6), and it would have been obvious to include the wrap-around feature in the combination of Manougian-Rago in order to enable the pivoting feature.

Claim 3: An interpretation of Manougian discloses a base portion **218** with a top face (portion holding third element **256'** of hook or loop material), and a lid **216** with a bottom face (portion holding fourth element **254'** of hook or loop material).

Claims 11 and 12: Manougian-Rago discloses the claimed invention except for the shape of the first element. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the first element of Manougian-Rago with the claimed wedge shape in order to conform to the increasing diameter of the base. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47. A change in aesthetic (ornamental) design generally will not support patentability. *In re Seid*, 73 USPQ 431.

Claims 14, 15, 19, and 20: Base **218** of Manougian is a semi-circular cylinder; therefore the first element of the hook-and-loop hinge would comprise a fraction fixed on a surface that is not planar.

Claim 24: Manougian discloses relief portion **258** and cooperating portion **264**.

Claims 26, 27, and 36: Manougian discloses housing **252** containing substance **214** that is a cosmetic substance; housing **252** is a dish.

Claim 28: Manougian discloses housing **242** with applicator **244** located on the lid portion. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the housing and applicator in the base portion in order to allow for a larger mirror. It has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Claim 29: Manougian discloses housing **252** having a bottom comprising one of hooks and loops **256**.

Claims 30 and 31: Manougian discloses mirror **240** on a bottom face of lid **216**.

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Claim 34: Manougian discloses box **210** as a cosmetic box (see for example the Abstract).

Claim 35: Manougian-Rago discloses the claimed structure, and Rago teaches the obvious use of the hook-and-loop hinge (see Col, 3, lines 50-55).

5. Claims 4-6, 25, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manougian-Rago as applied to claims 1 and 3 above, and further in view of Flax (US 3,441,033) and Hunt (US 5,878,881; provided by applicant).

Manougian-Rago discloses the claimed invention except for the stacking base with hook-and-loop attachment.

Flax teaches a stacking base **12/14/16**. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the box of Manougian-Rago with a stacking base as taught by Flax in order to retain a larger number of articles. Flax also suggests cooperating relief's **32/38**.

Hunt teaches the use of hook-and-loop fasteners **66/68** for the connection of multiple bases **24** (see Figure 17) and it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the box of Manougian-Rago with hook-and-loop fasteners on the bottom of base **218** as taught by Hunt in order to hold the plurality of bases together.

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6. Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manougian-Rago as applied to claim 1 above, and further in view of Beasley et al (US 5,115,916; hereinafter Beasley).

Manougian-Rago discloses the claimed invention except for the setback portion.

Beasley teaches a hook-and-loop fastener placed in a setback portion (see Figure 6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the hook-and-loop hinge of Manougian-Rago in a setback portion as taught by Beasley in order to accurately locate the hinge parts during assembly.

7. Claims 1, 2, 7-10, 13, 17, 18, 21, 26-28, 30-36, 38, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seidler (US 2002/0153376 A1) in view of Rago et al (US 6,626,432 B2; hereinafter Rago).

Claim 1: Seidler discloses a box **30** with at least one base portion **34**, a lid **32**, and a hinge **16/18** comprising first element **18** and second element **16** and capable of retaining the lid in an upstanding position (see Figure 13). Seidler discloses the hinges as magnets instead of the hook-and-loop fasteners claimed by the applicant.

Rago discloses a hinge **22** (see Figure 6) with a first element **62** comprising loop materials and a second element **72** comprising hook materials. Rago shows that a hook-and-loop hinge was an equivalent structure known in the art. Therefore, because these two hinge means were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute the hook-

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and-loop of Rago for the magnets of Seidler. An express suggestion to substitute one equivalent component or process for another is not necessary to render such substitution obvious. *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982).

Claims 2, 17, 18, and 21: Rago teaches the hook-and-loop fastener wrapping around the top, side, and bottom of the base and lid (see Figure 6), and it would have been obvious to include the wrap-around feature in the combination of Manougian-Rago in order to enable the pivoting feature.

Claims 7-10: Seidler discloses two complementary, distinct hinge portions disposed at opposite side faces of the base and lid.

Claim 13: Upper and lower portions of the base and lid of Seidler are planar and Rago teaches wrapping the hook-and-loop material around the planar portions.

Claims 26, 27, and 36: Seidler discloses housing with cosmetic substance **38** contained in a dish **40**.

Claim 28: Seidler discloses housing **42**.

Claims 30 and 31: Seidler discloses mirror **36** on a bottom face of lid **32**.

Claim 32: Seidler discloses second base portion **50**.

Claim 33: The hinge elements are removable, and therefore considered movable.

Claim 34: Box **30** of Seidler is a cosmetic box.

Claim 35: Seidler discloses the claimed method of use (see Figure 4).

Claims 38 and 39: Seidler discloses a system comprising a first base portion **34** including a housing receiving at least one cosmetic substance **38**, a second base

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portion 50 including a housing receiving at least one cosmetic substance 38 (see paragraph [0052]), the first and second base portions having the claimed face arrangements, a lid 32, a hinge 16/18/52 comprising first element 18, second element 16. Seidler discloses the hinges as magnets instead of the hook-and-loop fasteners claimed by the applicant.

Rago discloses a hinge **22** (see Figure 6) with a first element **62** comprising loop materials and a second element **72** comprising hook materials. Rago shows that a hook-and-loop hinge was an equivalent structure known in the art. Therefore, because these two hinge means were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute the hook-and-loop of Rago for the magnets of Seidler. An express suggestion to substitute one equivalent component or process for another is not necessary to render such substitution obvious. *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982).

Seidler discloses two complementary, distinct hinge portions disposed at opposite sides of the base, second base, and lid, at least two of which may be considered cooperating third and fourth elements.

8. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Seidler-Rago as applied to claim 1 above, and further in view of Vicari (US 6,216,899).

Seidler-Rago discloses the claimed invention except for the hook-and-loop catch. Vicari teaches a tab **30'** of one of hook or loop material and a catch **20'** of the other of hook or loop material for securing the lid in a closed position and for said purpose, it

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would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the box of Seidler-Rago with a tab and catch as taught by Vicari.

Response to Arguments

9. Applicant's arguments filed 13 April 2007 have been fully considered but they are not persuasive.

10. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

11. A *prima facie* case of obviousness is established by presenting evidence indicating that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having those teachings before him to make the proposed combination or other modification. See *In re Lintner*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972). An express suggestion to substitute one equivalent component or

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process for another is not necessary to render such substitution obvious. *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982).

12. In response to applicant's argument that Rago is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Rago is pertinent to hinge structures.

13. In response to the applicant's argument that Manougian teaches away from the claimed invention, disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). Furthermore, "[t]he prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed...." *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

14. Applicant's argument that the claimed hinge structure would render Manougian unsuitable for its intended purpose is not found persuasive since the cited reinforcement is considered optional by Manougian, and not a required feature. Moreover the

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principal of operation (i.e. the hinge feature) is not changed by substituting one hinge structure for another.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Greg Pickett/
Examiner
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